

Application Number: 09/884,600

Docket Number: 10011123-1

REMARKS

Upon entry of this Response, claims 1-24 remain pending in the present application. Applicants respectfully request reconsideration of the pending claims in view of the following remarks.

In item 2 of the Office Action, claims 1-3, 8-10, 15-17, and 22-24 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,714,968 issued to Prust (hereafter "*Prust*"), further in view of U.S. Patent No. 5,826,269 issued to Hussey (hereafter "*Hussey*"). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP 2143.03, *In re Rijckaert*, 9F.3d 1531, 28 U.S.P.Q 2d 1955, 1956 (Fed. Cir. 1993). For the reasons that follow, Applicants assert that the rejection of claims 1-3, 8-10, 15-17, and 22-24 is improper. Accordingly, Applicants request that the rejection of these claims be withdrawn.

To begin, claim 1 as previously amended recites as follows:

1. A document retrieval method, comprising:
 - receiving a request email message from a requesting device via a network, the request email message embodying a document request;
 - determining from the request email address whether a destination address on the network to which at least one document specified in the document request is to be sent is a third party address or an originator address on the network, the originator address being associated with the requesting device;
 - automatically generating a forwarding email message with the at least one document attached thereto in response to the document request if the at least one document specified in the document request is to be sent to the third party address, the forwarding email message being addressed to the third party address;
 - automatically generating a reply email message with the at least one document attached thereto in response to the document request if the at least one document specified in the document request is to be sent to the originator address on the network, the reply email message being addressed to the originator address; and
 - automatically transmitting the response email message to the destination address on the network.

As set forth above, claim 1 specifies that the request email message received from a requesting device that embodies a document request is examined and it is determined whether a destination address on a network to which the document is to be sent is either a third party address or an originator address on the network, where the originator address is associated with the requesting device. In this respect, the

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document is sent to either the third party address or the originator address. Claim 1 further specifies that a forwarding email message is automatically generated with the requested document attached if the document is to be sent to the third party address, where the forwarding email message is addressed to the third party address. Alternatively, a reply email message is generated if the requested document is to be sent to the originator address associated with the requesting device.

With respect to claims 1, 8, 15, and 22, the Office Action states as follows:

"However, Prust did not explicitly state determining from the request email address whether a destination address on the network to which at least one document specified in the document request is to be sent is a third party address or an originator address on the network, the originator address being associated with the requesting device; and automatically generating a forwarding email message with the at least one document attached thereto in response to the document request if the at least one document specified in the document request is to be sent to the third party address, the forwarding email message being addressed to the third party address.

In an analogous art of email systems, Hussey disclosed and electronic interface for a network server in which clients send email requests and an email response builder generates a response email message, with an attached document, to be issued to the originator of the corresponding email address as well as any other "copied" email accounts originally designated in the "cc:" field (Hussey, col. 11, lines 55-67, col. 12, lines 1-10).

Both Prust and Hussey provide emailing systems where users request data. Hussey goes into further detail of the standard functions of the emailing systems.

Therefore it would have been obvious to one in the ordinary skill in the art at the time of the invention to incorporate the basic functionalities of an email system as taught in Hussey into Prust to provide users with a system that processes user requests for shared resources administered by the server (Hussey, col. 3, lines 30-40)." (Office Action, page 3).

As set forth above, the Office Action admits that *Prust* fails to show or suggest determining whether a destination address on the network for documents to be sent is to be a third party address or an originator address associated with the requesting device. Also, the Office Action admits that *Prust* fails to show or suggest automatically generating the forward email address with the document attached thereto in response to the document request if the document specified in the document request is to be sent to the third party address, where the forwarding email message is addressed to the third party address on the network.

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Reiterating the above statement, the Office Action particularly alleges:

"Hussey disclosed an electronic interface for a network server in which clients send email requests and an email response builder generates a response email message, with an attached document, to be issued to the originator of the corresponding email address as well as any other "copied" email accounts originally designated in the "cc:" field." (Office Action, page 3).

Admittedly, *Hussey* describes the concept of generating a reply email address to a request that is sent to both the email address of the originating device as specified in the "From" field of the request, and any addresses noted in the "CC" field. However, *Hussey* fails to show or suggest the concept of determining whether a response to a document request is to be transmitted to a third party address or an originator address on a network as claimed. Rather, all addresses to which a response is to be sent are provided in the email request, and no decision need be made as to whether one address or another is to be employed in sending the documents as described in claim 1.

In addition, where the structure or text of prior art suggests something other than the instant invention, then it teaches away from the invention, and ultimately, does not suggest the creation of the invention. *Akzo N.V. v U.S. Intern. Trade Comm.*, 808 F.2d 1471, 1 U.S.P.Q.2d (Fed. Cir. 1986), cert. denied, 482 U.S. 909. In this respect, *Hussey* teaches away from the concept of making the determination as to whether an originator address in the "From" field or a specified third party address is to be employed to send a document in response to a received document request. *Hussey* teaches the use of all addresses in the request and avoids the complications of determining specifically where the document is to be sent. Thus, *Hussey* teaches away from making a decision as to whether the originator address is to be employed in a reply or a third party address is to be employed in a forwarding email to send the requested documents to the desired location.

In addition, the Office Action states *Hussey* teaches or suggests an "email response builder" that generates a response email message "with an attached document". Applicants respectfully disagree. *Hussey* merely contemplates transmission of information harvested from a database. Such information does not constitute a document.

In view of the foregoing, Applicants assert that the rejection of claim 1 is improper. In addition, Applicants assert that the rejection of claims 8, 15, and 22 is

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improper to the extent that such claims incorporate subject matter similar in scope of that of claim 1. Accordingly, Applicants request that the rejection of claims 1, 8, 15, and 22 be withdrawn. In addition, Applicants request that the rejection of claims 2, 3, 9, 10, 16, 17, 23, and 24 be withdrawn as depending from claims 1, 8, 15, or 22.

In addition, claims 4, 11, and 18 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Prust* in view of *Hussey* and further in view of U.S. Patent No. 6,084,952 issued to Beerman, Jr., et al. (hereafter "*Beerman*"). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP 2143.03, *In re Rijnckaert*, 9F.3d 1531, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). Applicants assert that the cited combination of *Prust*, *Hussey* and *Beerman* fails to show or suggest each of the elements of claims 4, 11, and 18 as depending from claims 1, 8, and 15. Accordingly, Applicants request that the rejection of claims 4, 11, and 18 be withdrawn for the same reasons described above with respect to claims 1, 8, and 15.

Next, claims 5, 12, and 19 have been rejected under rejected under 35 U.S.C. §103(a) as being unpatentable over *Prust* in view of International Patent Publication No. WO 01/33874 by Cho, et al. (hereafter "*Cho*"). Applicants respectfully assert that the cited combination of *Prust* and *Cho* fails to show or suggest each of the elements of claims 5, 12, and 19, as depending from claims 1, 8, and 15 for the reasons described above. Accordingly, Applicants request that the rejection of claims 5, 12, and 19 be withdrawn as depending from claims 1, 8, and 15.

Next, claims 6, 7, 13, 14, 20, and 21 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Prust*, *Cho*, and U.S. Patent No. 6,212,268 issued to Nielsen (hereafter "*Nielsen*"). Applicants assert that the cited combination of *Prust*, *Cho* and *Nielsen* fail to show each of the elements of claim 6, 7, 13, 14, 20, and 21 as depending from claims 1, 8, or 15. Accordingly, Applicants request that the rejection of claim 6, 7, 13, 14, 20, and 21 be withdrawn for the same reasons described above with respect to claim 1, 8, and 15.

In addition, in response to Applicants previous amendments, in the section entitled "Response to Amendment", the Office Action goes to great lengths to state that the claims must further be amended beyond the amendments presented in the response to the previous Office Action with the statement

"[T]he independent claims include nothing more than the basic functions of a web mail server. A user stores an email

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in his inbox at a web mail server. The email containing an attached document. The user of the web mail system can make an email request to forward this email to multiple recipients, including the users own email address. The web mail server receives its email request, parses the email to identify all the recipients, creates multiple emails with the document attached and transmits each email to each recipient separately. A user simply forwarding an email to multiple addresses including the user's address satisfies limitations of the claims. This function is well-known and is used in standard emailing systems." (Office Action, page 7.)

Applicants respectfully disagree. Nothing in the cited references describes making a determination as to whether a document is to be sent to a forwarding email address of the originating email address as claimed. In addition, Applicants assert that such features are not shown or suggested in the cited references, nor are such features commonly known by those skilled in the art.

Specifically, the claims specify automated systems to provide access to documents from a distance over the Internet or other networks as set forth in the instant claims. The cited references fail to show or suggest each of the elements of the instant claims as set forth above. To the extent that the Office Action makes generic reference to the fact that email systems exist without specifically explaining how references show or suggest each of the elements of the instant claims, it follows that the rejection is necessarily based upon the personal knowledge of the Examiner.

When a rejection in an application is based on facts within the personal knowledge of an Examiner, it should be as specific as possible. Once called for by the Applicants, the Examiner must support the assertion that an Affidavit which is subject to contradiction or explanation by the Affidavits of the Applicants' or other persons. 37 C.F.R. §1.104(d)(2). To the extent that the Office Action relies upon the personal knowledge of the Examiner in generating an objection of elements not specifically shown or suggested in the references, Applicants expressly request that an Affidavit attesting to the facts within the personal knowledge of the Examiner be provided in this case.

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CONCLUSION

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,



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